UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,641	07/31/2001	Yuji Shinohara	325772026100	1557

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ART UNIT	PAPER NUMBER
2145	

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>14 March 2005</u>.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-19</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-19</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>31 July 2001</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a) ☒ All   b) ☐ Some * c) ☐ None of:

       1. ☒ Certified copies of the priority documents have been received.

       2. ☐ Certified copies of the priority documents have been received in Application No. _____.

       3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
     Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☒ Other: *see attached office action.*

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments filed 3/14/05 have been fully considered but they are not

persuasive. An analysis is provided below.

2.   In the response to the last office action, the applicant changed the scope of the claims by

adding "user sends the e-mail message" to all independent claims. As a result, a final

amendment is necessitated even if the examiner provides a new art rejection. The examiner

acknowledges that no new matter has been added by this amendment.

3.   Regarding the 112 rejection, the examiner's complaint was not with the term

"destination" but its use within claims 12-19. Hence, the simple substitution of "receiver" in

place of "destination" does not solve the prior issues, and in point of fact makes things worse.

The examiner will try to walk the applicant through the problem so that this issue may be

resolved.

4.   Regarding the new addition of "an e-mail message sending step wherein the user sends

the e-mail message." The claims as drawn do now show that a user provides the keyword and

sends the e-mail message, but does not clarify whether the user sends the keyword to a remote

server, receives the document, or performs document extraction, nor is it clarified whether the

document be local or remotely stored, nor is it clarified how the extraction takes place. Because

of the broadness of the claims, it is further not clarified how the timetable occurs. In other

words, the added limitation may be fulfilled by a variety of methods, including a user forwarding

an e-mail or web page, a user utilizing copy and paste functionality to paste data such as search

results and summaries into an e-mail, and a user requesting a server to send results both to him and to another user. All of these methods are well known in the art.

5.		Salam teaches the knowledge engine, which has been shown to accept keywords from a user, accept document files containing the keyword, extracting data corresponding to the keyword, and transmits the extracted data to the user via e-mail or other methods including display through a browser (Figs. 17-20). Salam also teaches that "the user may electronically mail the listing and summary provided by the knowledge engine to another user (col. 28, lines 10-20). The details of this method clearly show the user preparing the message, with the attached data, and sending the message by use of the go button (col. 32, lines 14-30). Alternately, the user can simply use the browser's send item command (col. 28, line 20). At the time the invention was made, one of ordinary skill in the art would have wanted to share search results and knowledge with others (col. 28, lines 12-13). Therefore, Salam still teaches all the items within the independent claims.

6.		For the reasons above, the rejection is maintained and therefore made final.

Claim Rejections - 35 USC § 112

7.		The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8.		Claims 12-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9.   The examiner interprets, as best as he is able, that there is a first user that submits a

keyword and sends the e-mail, a second user that receives the e-mail, and a document that may

be local or remote to the users, due to the breadth of the claims. It is not clear which of the two

users, if either, constitutes the "receiver." The issue complicates with the "data receiver setting

step for setting the receiver as a sending receiver of the extracted data." It is further not clear

whether the "receiver" acts in claim 12 in the same manner as "keyword" acts in claim 1.

10.   Claims 12-19 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete

for omitting essential structural cooperative relationships of elements, such omission amounting

to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted

structural cooperative relationships are: the receiver's relationship to the first user, the second

user, and the optional server, as shown above.

11.   Where applicant acts as his or her own lexicographer to specifically define a term of a

claim contrary to its ordinary meaning, the written description must clearly redefine the claim

term and set forth the uncommon definition so as to put one reasonably skilled in the art on

notice that the applicant intended to so redefine that claim term. *Process Control Corp. v.*

HydReclaim Corp., 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term

"receiver" in claims 12-19 are used by the claim to mean "data to be transmitted and/or set",

while the accepted meaning is "a person or object that receives." The term is indefinite because

the specification does not clearly redefine the term. For the purposes of this action, the examiner

will assume that the receiver is the second user, and that there is information attached to the

receiver that may act as a search keyword and/or as an e-mail destination address. The

information attached to the receiver may include, but is not limited to, the second user's name,

organization, group, address, telephone number, or e-mail address.

Claim Objections

12.   Claim 12 is objected to because of the following informalities: "setting the receiver as a

sending receiver." Appropriate correction is required.

Claim Rejections - 35 USC § 102

13.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14.   Claims 1, 2, 11-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Salam et

al. (6,594,654).

15.   For claims 1, 18, and 19, Salam teaches a data processing (col. 1, line 1 – col. 7, line 42)

method (abstract) comprising:

    a.   A keyword accepting step (Fig. 14, #1401) for accepting a keyword (col. 5, lines

    35-40) from a user (Fig. 3, #304);

    b.   A document file accepting step (Fig. 1, #12) for accepting a document file (col. 5,

    lines 45-50; col. 6, lines 13-20);

       c.   A data extracting step (col. 14, lines 20-30) for extracting data corresponding to

the keyword, from the document file (col. 15, lines 8-20);

       d.   A data attaching step for attaching the extracted data to an e-mail message (col. 9,

line 65 – col. 10, line 15; col. 15, lines 27-31); and

       e.   An e-mail message sending step (Fig. 20) wherein the user sends the e-mail

message (col. 28, lines 10-20).

16.   For claim 2, Salam teaches that the data corresponding to the keyword is data that

includes the keyword (col. 15, lines 5-20).

17.   For claim 11, Salam teaches that the e-mail message is an HTML-format message (Fig.

20, #2003).

18.   Claims 12-14 are drawn to the limitations in claim 1. Salam also teaches the added

limitations of accepting a receiver (Fig. 13) and extracting data corresponding to the receiver

(col. 8, line 65 – col. 9, line 5). Therefore, since claim 1 is rejected, claims 12-14 are also

rejected for the reasons above.

19.   Claims 15 and 16 are drawn to the limitations in claims 1 and 12. Therefore, since claims

1 and 12 are rejected, claims 15 and 16 are also rejected for the reasons above.

20.   Claim 17 is drawn to the limitations in claim 15. Salam also teaches the added

limitations of accepting, and choosing from, a plurality of destinations (col. 22, lines 60-65).

Therefore, since claim 15 is rejected, claim 17 is also rejected for the reasons above.

Claim Rejections - 35 USC § 103

21.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

22.   Claims 3-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Salam as

applied to claim 1 above, and further in view of Christensen et al. (6,347,320).

23.   For claim 3, Salam does not expressly disclose that the data corresponding to the

keyword is a paragraph. Salam does teach that the amount of data may be selected. Christensen

teaches a method (abstract) of searching HTML files (col. 1, line 1 – col. 4, line 16), in which the

included text may be between any two tags (col. 6, line 63 – col. 8, line 25) including within text

paragraphs (Fig. 5). At the time the invention was made, one of ordinary skill in the art would

have used Christensen's HTML-tag method to limit results to more relevant files (col. 3, lines

44-47).

24.   For claim 4, Salam teaches that the document is an HTML file (col. 9, lines 20-35), but

does not expressly disclose that extracting the paragraph is data that begins after a paragraph

start tag and ends before a paragraph end tag. Christensen teaches this limitation (col. 7, lines 1-

15). At the time the invention was made, one of ordinary skill in the art would have used

Christensen's HTML-tag method to limit results to more relevant files (col. 3, lines 44-47).

25.   For claim 5, Salam does not expressly disclose that the data corresponding to the

keyword is a row corresponding to the keyword from a table included in the document file.

Christensen teaches this limitation (col. 8, lines 8-12). At the time the invention was made, one

of ordinary skill in the art would have used Christensen's table method in Salam to limit results

to more relevant files (col. 3, lines 44-47).

26.   For claim 6, Salam does not exprtessly disclose that the document is an HTML file, and

the row is data that begins after a table row start tag and ends before a table row end tag.

Christensen teaches this limitation (col. 7, lines 1-15). At the time the invention was made, one

of ordinary skill in the art would have used Christensen's HTML-tag method to limit results to

more relevant files (col. 3, lines 44-47).

27.   For claim 7, Salam does not expressly disclose that the data corresponding to the

keyword is a column corresponding to the keyword from a table included in the document file.

Christensen teaches this limitation (col. 8, lines 8-12). At the time the invention was made, one

of ordinary skill in the art would have used Christensen's table method in Salam to limit results

to more relevant files (col. 3, lines 44-47).

28.   For claim 8, Salam does not expressly disclose that the document is an HTML file, and

the column is made up of one or more sets of data that begin after a table data cell start tag and

end before a table data cell end tag. Christensen teaches this limitation (col. 7, lines 1-15). At

the time the invention was made, one of ordinary skill in the art would have used Christensen's

HTML-tag method to limit results to more relevant files (col. 3, lines 44-47).

29.   For claim 9, Salam does not expressly disclose that the data corresponding to the

keyword is a cell corresponding to the keyword from a table included in the document file.

Christensen teaches this limitation (col. 8, lines 8-12). At the time the invention was made, one

of ordinary skill in the art would have used Christensen's table method in Salam to limit results

to more relevant files (col. 3, lines 44-47).

30.   For claim 10, Salam teaches that the document is an HTML file, and the cell is data that

begins after a table data cell start tag and ends before a table data cell end tag. Christensen

teaches this limitation (col. 7, lines 1-15). At the time the invention was made, one of ordinary

skill in the art would have used Christensen's HTML-tag method to limit results to more relevant

files (col. 3, lines 44-47).

Conclusion

31.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing
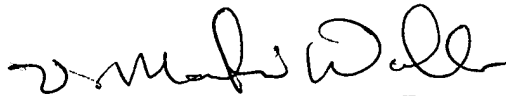
date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Melvin H. Pollack whose telephone number is (571) 272-3887.

The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Valencia Martin-Wallace can be reached on (571) 272-6159. The fax phone number

for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MHP
07 June 2005

VALENCIA MARTIN-WALLACE
SUPERVISORY PATENT EXAMINER